

### **REMARKS**

In response to the Office Action of January 30, 2007, Applicant has amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicant reserves the right to prosecute the same or similar subject matter in this or another application.

Claims 1-34 are pending in this application. By this Amendment, Claim 33 has been amended, Claims 22-32 which were withdrawn from consideration due to a restriction requirement, have been canceled herein without prejudice and new Claim 35 has been added. Applicant respectfully reserves the right to file one or more divisional applications to Claims 22-32. Accordingly, Claims 1-21, and 33-35 are now under examination in this case. Support for the amendment of Claim 33 can be found throughout the specification, e.g., page 6, line 11 through page 7, line 12. Applicant respectfully submits that no new matter has been added to this application. Moreover, it is believed that the claims as presented herein places the application in condition for allowance.

The Examiner has rejected Claims 1-3, 5-9, 21, 33 and 34 under 35 U.S.C. §102(b) as being anticipated by Francisco et al. U.S. Patent No. 5,308,522 ("Francisco et al.").

Francisco et al. disclose a lubricant composition containing (a) a major amount of a lubricating oil basestock and (b) a minor amount of a benzotriazole for improving the load-carrying capacity of a lubricant composition under load conditions. Francisco et al. further

disclose in Example 3 testing a commercially available amine phosphate additive against compounds I and II from Example 2 for elastomer seal stability by measuring the volume and tensile strength of a silicone elastomer specimen before and after it is contacted with a test formulation containing the desired load additive. The percent swell and percent change in tensile strength are calculated from these measurements and reported in Table 2 therein.

In contrast to the presently claimed invention, Francisco et al. fail to disclose a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of: (a) providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) providing at least one elastomer; (c) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and, (d) outputting the results of step (c) as presently recited in Claim 1.

It is well established that, for a claim to be anticipated, a single prior art reference must disclose each and every element of the claimed invention, *either expressly or inherently*. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, (Fed. Cir. 1987); *cert. denied*, 484 U.S. 1007 (1988). The high throughput method, as set forth in the present claims, is conducted under program control, i.e., automated, such that a relatively large number of different lubricating oil composition samples can be rapidly prepared and screened for elastomer compatibility data. Certainly, nothing in Francisco et al., much less Example 3 of Francisco et al., which is relied upon by the Examiner, even remotely discloses a high throughput method

conducted under program control. In contrast, Example 3 of Francisco et al. simply disclose measuring elastomer compatibility for a commercially available amine phosphate additive against compounds I and II from Example 2. Thus, Francisco et al. do not disclose all of the elements and limitations of the claimed invention. For the foregoing reasons, Claims 1-3, 5-9, and 21 are believed to be novel over Francisco et al.

With respect to Claim 33, Francisco et al. likewise fail to disclose a combinatorial lubricating oil composition library comprising lubricating oil composition elastomer compatability data stored on a programmed controller for a plurality of different lubricating oil compositions comprising (a) a major amount of a base oil of lubricating viscosity and (b) at least one lubricating oil additive as presently recited in Claim 33.

Rather, Francisco et al. simply disclose elastomer seal stability, competitor lube compatibility and self compatibility measurements in Table 2 for a commercially available amine phosphate additive against compounds I and II from Example 2. At no point is there any disclosure in Francisco et al. of a combinatorial library obtained from a high throughput method for storing lubricating oil composition elastomer compatability data on a programmed controller for a plurality of different lubricating oil compositions. Certainly, the results listed in Table 2 of Francisco et al. are not a combinatorial lubricating oil composition library comprising lubricating oil composition elastomer compatability data stored on a programmed controller for a plurality of different lubricating oil compositions comprising (a) a major amount of a base oil of lubricating viscosity and (b) at least one lubricating oil additive as set forth in the present claims. Thus, Francisco et al. do not disclose all of the elements and limitations of the claimed invention.

For the foregoing reasons, amended Claims 33 and 34 and new Claim 35 are believed to be novel over Francisco et al.

Accordingly, withdrawal of the rejection of Claims 1-3, 5-9, 21, 33 and 34 under 35 U.S.C. §102(b) is respectfully requested.

The Examiner has rejected Claims 1, 2, 4, 5, 8 and 10-12 under 35 U.S.C. §102(b) as being anticipated by Migdal et al. U.S. Patent No. 5,062,980 ("Migdal et al."). This rejection is respectfully traversed.

Migdal et al. disclose a novel additive which improves the dispersancy and Viton<sup>®</sup> Seal compatibility of a lubricating oil. Migdal et al. further disclose in Example X testing lubricating oil compositions containing the additive for Viton<sup>®</sup> Seal compatibility using an AK-6 Bend Test. The AK-6 Bend Test disclosed in Migdal et al. is conducted as follows:

Specifically, a 38 by 9.5 mm slab of a Viton<sup>®</sup> AK-6 rubber cut with the grain of the rubber is placed in a 30 ml wide-mouth bottle with 20 ml of the test oil. The bottle is sealed and the test sample placed in an oven at 149°C for 96 hours. The bottle is removed from the oven and the rubber specimen taken from the initial bottle and placed into a second bottle with a new charge of test oil. After 30 minutes in the new oil charge, the rubber specimen is removed from the second bottle and submitted to a Bend Test. This is done by bending the rubber specimen 180°. The degree of cracking is observed and reported as follows: no cracking (NC), surface cracking (SC) or cracking (C). If cracking is observed, the test is terminated on that particular sample.

If no cracking has been observed, the rubber specimen is returned to the bottle containing the second oil charge and this bottle is returned to the oven maintained at 149°C, the bottle is removed from the oven and the rubber specimens withdrawn and placed into another bottle containing a fresh oil charge for 30 minutes, following which the bend test is repeated.

In contrast to the presently claimed invention, Migdal et al. fail to disclose a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of: (a) providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) providing at least one elastomer; (c) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and, (d) outputting the results of step (c) as presently recited in Claim 1.

As previously stated, the high throughput method, as set forth in the present claims, is conducted under program control, i.e., automated, such that a relatively large number of different lubricating oil composition samples can be rapidly prepared and screened for elastomer compatibility data. At no point is there any disclosure in Migdal et al. much less Example X of Migdal et al., which is relied upon by the Examiner, of an automated high throughput method for screening a plurality of different lubricating oil composition samples for elastomer compatibility data. In contrast, Example X of Migdal et al. merely discloses individually testing lubricating oil composition samples for elastomer compatibility. Thus, Migdal et al. do not disclose all of the elements and limitations of the claimed invention. For the foregoing reasons, Claims 1, 2, 4, 5, 8 and 10-12 are believed to clearly possess novel subject matter relative to Migdal et al. Accordingly, withdrawal of the rejection of Claims 1, 2, 4, 5, 8 and 10-12 under 35 U.S.C. §102(b) is respectfully requested.

The Examiner has rejected Claims 1-3, 5-9, 15, 16, 21, 33 and 34 under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Chaffee et al. U.S. Patent No. 4,774,281 ("Chaffee et al.").

The deficiencies of Francisco et al. discussed above with respect to rejection of amended Claims 1 and 33 apply with equal force to this rejection. Chaffee et al. do not cure and is not cited as curing the deficiencies of Francisco et al. Rather, Chaffee et al. simply disclose silicone rubber compositions that are individually tested for physical properties. As such, even by combining Chaffee et al. with Francisco et al., one skilled in the art would not even arrive at the claimed high throughput method or the claimed combinatorial library. For the foregoing reasons, Claims 1-3, 5-9, 15, 16, 21, 33 and 34 are believed to be nonobvious, and therefore patentable, over Francisco et al. and Chaffee et al. Accordingly, withdrawal of the rejection of Claims 1-3, 5-9, 15, 16, 21, 33 and 34 under 35 U.S.C. §103(a) is respectfully requested.

The Examiner has rejected Claims 1-3, 5-9, 11-14, 17-21, 33 and 34 under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Kolosov et al. U.S. Patent Application Publication No. 2004/0123650 ("Kolosov et al.").

The deficiencies of Francisco et al. discussed above with respect to rejection of Claims 1 and 33 apply with equal force to this rejection. It well established that there must be some teaching, motivation or suggestion to select and combine references relied upon as evidence of obviousness. As is the case here, Kolosov et al. provide no teaching, motivation or suggestion that a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least

one lubricating oil additive, can be screened for the compatibility of the compositions with elastomers under program control in a high throughput method as presently recited in Claim 1. Nor, for that matter does Kolosov et al. provide any teaching, motivation or suggestion of a combinatorial library obtained from a high throughput method for storing lubricating oil composition elastomer compatibility data on a programmed controller for a plurality of different lubricating oil compositions, as recited in present Claim 33.

In contrast, Kolosov et al. simply disclose a method for screening a library of materials for rheological properties *of the material* such as viscosity, viscoelasticity (e.g., shear dependent viscoelasticity), shear thinning, shear thickening, yield, stress and the like. Kolosov et al. provide no suggestion or motivation to measure the compatibility of the material with another material. In contrast, the primary goal of Kolosov et al. is to determine a property of the sample of interest. Applicant, however, has discovered that elastomers, which are susceptible to serious deterioration from lubricating oil compositions containing (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, can be screened for elastomer compatibility of each lubricating oil composition sample in a high throughput manner, under program control. As such, nothing in Kolosov et al. would lead one skilled in the art to look to the method for determining rheological properties of the samples disclosed therein to modify the manual test of Francisco et al. and arrive at the presently claimed invention. Only by using Applicant's disclosure as a guide has the Examiner been able to piece together the claimed invention. Accordingly, Claims 1-3, 5-9, 11-14, 17-21, 33 and 34 are

believed to be nonobvious, and therefore patentable, over Kolosov et al. and Francisco et al.

Thus, withdrawal of the rejection is respectfully requested.

The Examiner has provisionally rejected Claims 1-3 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of U.S. Patent No. 7,137,289 in view of Francisco et al. and further in view of Bailey et al. U.S. Patent No. 3,108,397 ("Bailey et al."). Upon resolution of all outstanding issues remaining in the Office Action, Applicant will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1-3 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of co-pending U.S. Serial No. 11/528,747 in view of Bailey et al. Initially, it is noted that the Examiner's rejection based on U.S. Serial No. 11/528,747 appears to contain a typographical error. Instead, Applicant believes that the correct U.S. Serial No. is 11/582,747 and clarification is respectfully requested. However, upon resolution of all outstanding issues remaining in the Office Action, Applicant will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of co-pending U.S. Serial No. 11/699,510 in view of Francisco et al. Upon resolution of all outstanding issues remaining in the Office Action, Applicant will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of co-pending U.S. Serial Nos. 11/605,127; 10/699,508; 10/699,507 and 10/779,422 in view of Francisco et al. and further



Appln. No. 10/779,421  
Response dated April 30, 2007  
Response to Office Action dated January 30, 2007

in view of Guinther et al. U.S. Patent Application Publication No. 2004/0074452 ("Guinther et al."). Upon resolution of all outstanding issues remaining in the Office Action, Applicant will consider the timely submission of a Terminal Disclaimer.

For the foregoing reasons, amended Claims 1-21, 33 and 34 and new Claim 35 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael E. Carmen".

Michael E. Carmen  
Reg. No. 43,533  
Attorney for Applicants

M. CARMEN & ASSOCIATES, PLLC  
170 Old Country Road – Suite 400  
Mineola, NY 11501  
(Phone) (516) 992-1848  
(Facsimile) (516) 739-0981  
MEC:bg